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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/759,358

01/16/2004

Donna A. Piacenza

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1131 7590 11/05/2007  
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EXAMINER

AKRAM, IMRAN

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

11/05/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/759,358	PIACENZA ET AL.	
	Examiner	Art Unit	
	Imran Akram	1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 13 and 18-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13 is/are allowed.
- 6) ☒ Claim(s) 18-20 and 22-31 is/are rejected.
- 7) ☒ Claim(s) 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 8/29/07 have been fully considered but they are not persuasive. Applicant makes two arguments: Scordato does not teach a pivot selector and Scordato does not disclose a nozzle portion that rotates in any direction.
2. Scordato's teaching of a hinge being stiff enough to maintain a given angle (column 4, paragraph 36) is a pivot selector. The claim is given its broadest reasonable interpretation and without novel details in the claim differentiating the pivot selector from the prior art, it is anticipated by Scordato.
3. While the nozzle portion of Scordato cannot, indeed, be rotated in any direction, neither can that of the Applicant's invention (see new matter situation below).

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 28-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original specification and claims filed on

1/16/04 do not disclose a nozzle assembly capable of moving in "any direction." This is new matter in the amendment dated 8/29/07.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 18, 24, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Scordato (US 2002/0012513 A1).

2. Regarding claim 18, Scordato discloses a housing **12** defining a device axis (see figure 1A); a nozzle assembly **14** for accepting a pipette (It is well known in the art that pipette tips are nothing more than small pipettes themselves); a pivot mechanism for pivotally coupling the nozzle assembly to the housing, the pivot mechanism defining a pivot axis about which the nozzle assembly rotates relative to the housing (paragraphs 3 and 9). It is inherent the invention the pivot mechanism would include a first portion for coupling to the nozzle assembly and a second portion for pivotally coupling to the housing. Even though Scordato does not explicitly disclose details about the pivot mechanism, it would be necessary and thus inherent to have coupling between the housing and nozzle assembly that would allow for the nozzle to pivot.

3. Regarding claim 24, Scordato discloses an ergonomic hand grip (paragraph 13).

Art Unit: 1797

4. Regarding claim 27, Scordato discloses a device where the pivot axis is transverse to the device axis (see figure 1A). The device axis is the y-axis (from the base to the top) and the pivot axis is the z-axis.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

Art Unit: 1797

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 19, 20, 22, 23, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scordato (US 2002/0012613 A1) as applied to claim 18, and further in view of Raczak (US 3,656,351).

9. Regarding claim 19, Scordato discloses a plurality of indexing holes for pivotably orienting the nozzle assembly at a plurality of discrete angles (see paragraph 36). The screws of paragraph 36 are read to have complementary holes as this is commonly known about the function of screws. Scordato does not, however, disclose pivot bosses defining a pivot axis. Raczak discloses a pivot boss about which a nozzle assembly pivots (see column 1, line 66). It would be obvious to one skilled in the art at the time the invention was made to use bosses to pivot the nozzle assembly because it is commonly known in the art to do so. The number of pivot bosses defines only the preferred movement and it would have been obvious to include two in Scordato because of the type of movement claimed.

10. Regarding claim 20, claim 20 is read to include at least four indexing holes. Scordato discloses at least thirty-six (paragraph 36) indexing holes since the pivot angles are 10 degrees.

11. Regarding claim 22, Scordato does not disclose pivot sleeves. Raczak, however, discloses a pivot recess for engaging a pivot boss (see **51**, Figure 2). It would be obvious to one skilled in the art at the time the invention was made to include pivot sleeves with pivot bosses because the two by function cannot work without one another.

Art Unit: 1797

The number of pivot bosses defines only the preferred movement and it would have been obvious to include two sleeves in Scordato because of the type of axial movement claimed.

12. Regarding claim 23, Raczak discloses a pivot boss (see **22**, Figure 2) and a pivot sleeve for engaging a pivot boss (see **51**, Figure 2) that are generally frustoconical (column 1, line 66). The number of pivot bosses and complementary pivot sleeves define only the preferred movement and it would have been obvious to include two bosses and sleeves in Scordato because of the type of movement claimed.

13. Regarding claim 25, while Scordato discloses incremental pivoting with "a set screw or other adjustment permitting the nozzle assembly to be moved to a desired angle and then locked in place," Scordato does not disclose the use of nubs for this purpose. It would be obvious to one skilled in the art at the time the invention was made to include any such indentation or obvious, known catch mechanism to set the pivot into place.

14. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scordato (US 2002/0012613 A1) as applied to claim 18, and further in view of Sturm (US 4,099,548).

15. Regarding claim 26, Scordato does not disclose a slideable release having a pair of projections for engaging a pair of holes and a spring for biasing said slideable release to an engaged position with the indexing surface. Sturm, however, discloses a slideable release **19** having a projection **49** for engaging at least two holes in rack **43** and a spring **63** for biasing the slideable release **19** to an engaged position with the indexing surface

(column 4, lines 1-3). It would be obvious to one skilled in the art at the time the invention was made to use a spring and slideable release as their purpose is to return the pipette to its rest position and this is a known means to do so.

### ***Allowable Subject Matter***

16. Claim 13 is allowed.

17. Claim 21 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

18. The following is a statement of reasons for the indication of allowable subject matter: The inclusion of a indexing surface that is bisected and having each pair of holes comprising a pair of indents is unanticipated. There is no reason one of ordinary skill in the art would find to use these specific features for pivoting a pipette device's pivot mechanism.

### ***Conclusion***

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within



TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Imran Akram whose telephone number is 571-270-3241. The examiner can normally be reached on 9-5 Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Walter Griffin can be reached on 571-272-1447. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

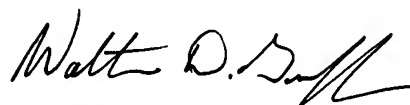
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Application/Control Number: 10/759,358

Page 9

Art Unit: 1797

IA

A handwritten signature in black ink, appearing to read "Walter D. Griffin". The signature is fluid and cursive, with a large, stylized "W" and "G".

WALTER D. GRIFFIN  
SUPERVISORY PATENT EXAMINER